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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/440,243 | 11/15/1999 | FRANK W. LIEBENOW | 450.264US1 | 2702 |

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EXAMINER

EICKHOLT, EUGENE H

ART UNIT PAPER NUMBER

2854

DATE MAILED: 01/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/440,243

Applicant(s)

LIEBENOW, FRANK W.

Examiner

Eugene H Eickholt

Art Unit

2854

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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The final rejection given in Paper No. 6 stands withdrawn so that newly developed art may be considered and also to address applicant's concerns regarding a detailed application of the rejection of the appealed claims.

Claims 1 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 remains rejected as being vague, indefinite and/or incomplete. The term "overriding" is broader than the argued superimposition or substitution of a new color printing code. It also can be reasonably interpreted as cancellation or erasure or deletion as recited in claim 8, which uses an even broader term to define a narrower term, meaning "changing" is broader than overriding..

The step of printing is incomplete as failing to be limited to sequential printing following the overriding step. Applicant has argued such a sequential printing step but not claimed clearly such a limited sequence.. Applicant is reminded that claims are given their broadest reasonable interpretation.

The drawings are objected to because the use of "Gateway" has no trademark designation. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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Claims 8, 15, 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims are vague, indefinite and/or unclear as to sequentially when the displayed text is printed, i.e., before subset color change or after, including the now changed color of the subset.

The use of the trademark Gateway has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 3-5, 7-8, 10-12, 14-15, 17-19, 20-24, 26-30 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Shisler et al.

The "global" or "template" report's color designation is "overridden" as set forth at page 9, paragraph N. 0123. Regarding claims 3 and 14, note the setting of default color if different than the globally set color of the report discussed at page 5, paragraph No. 0087.

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Regarding claim 4, note the description of the window 1502 at page 9, paragraph No. 0123 which refers to a current contents section.

Regarding claim 11, which calls for a precluding step, note the disclosure at page 5, paragraph No. 0089 concerning "whether printing of the object is to be suppressed" and also page 10-11, paragraph No. 0131 and the "hiding" teaching at page 12, paragraph No. 0148.

Regarding the "computer readable medium" of claims 12, 15 and 17 note the sensor computer storage of page 1, paragraph No. 0011. The "override module" of Shisler et al is the computer programming.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 6, 9-10, 13, 16, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shisler et al.

At the time of applicants invention it would have been an obvious design choice as to which color the user wished to change the global report color to, with black ink being the obvious choice when cost considerations are important. Note also, the "monochrome selection" taught at page 12, paragraph No. 0145 with "blacl" being well known to those skilled in the art as a preferred monochrome color.

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Regarding claim 10, note the teaching at page 9, paragraph No. 0120 of other identifying information, such as "use codes, and the like".

Claim 10 also rejected under 35 U.S.C. 103(a) as being unpatentable over the art cited above as applied to claim 8 above, and further in view of Levine et al (6,167,439).

Levine et al at column 10 teaches control of access to the "trays" by the user owner. It would have been obvious to one skilled in the printing art, a complex art, to have used the Levine et al user tray control feature with the Shisler et al network to restrict who may add or subtract or even inquiry concerning sensitive computerized files.

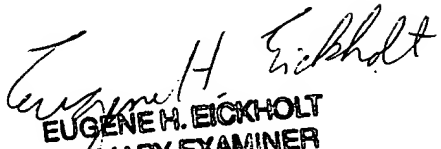
Applicant's arguments filed with the Brief have been fully considered but they are not persuasive. Applicant is reminded that the amendment of 09-24-01 was refused entry and is not acted upon although argued as if it were in the Brief.

A shortened statutory period of 3 months is set to respond.

Eickholt/ek

01/24/03


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